

ESTTA Tracking number: **ESTTA1155780**

Filing date: **08/26/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88646255
Applicant	Gunther's Quality Ice Cream, Inc.
Applied for Mark	GUNTHER'S
Correspondence Address	MARCUS N. DIBUDUO FENNEMORE CRAIG, P.C. 8080 N. PALM AVE., THIRD FL. FRESNO, CA 93711 UNITED STATES Primary Email: ipmail@dowlingaaron.com 559-432-4500
Submission	Applicant's reply brief
Attachments	Gunthers Reply Brief.pdf(153306 bytes)
Filer's Name	Marcus N. DiBuduo
Filer's email	ipmail@dowlingaaron.com
Signature	/Marcus N. DiBuduo/
Date	08/26/2021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Gunther's Quality Ice Cream, Inc.

Serial No. 88646255

Filed: Oct. 08, 2019

Mark: GUNTHER'S

APPLICANT'S REPLY BRIEF

The Trademark Office made final its refusal to register GUNTHER'S based on its belief a likelihood of confusion exists with previously registered marks under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d):

With respect solely to Applicant's Goods/Services in Cl. 43, the Office has cited Reg. No. 1435063 for the mark GUNTHER TOODY'S reciting use on "restaurant services", owned by Car 54, LLC.

With respect solely to Applicant's Goods/Services in Cl. 30, the Office has cited Reg. No. 4556314 for the mark GUNTHER'S GOURMET reciting use on "sauces", owned by Gunther's Gourmet Groceries, LLC.

Aug. 27, 2020 Final Office Action, TSDR p. 2.

The Examiner Brief was filed August 6. This Reply Brief is timely. The relevant *DuPont* factors here do not show *probable* confusion between Applicant's Mark GUNTHER'S and either the GUNTHER TOODY'S mark or the GUNTHER'S GOURMET mark. There is no likelihood of confusion. The Application to register GUNTHER'S should proceed to publication in both class 43 and class 30.

A. The marks are dissimilar in appearance, sound, meaning and commercial impression.

It is undisputed the similarity of the marks must be determined by comparing the marks in their entireties as to appearance, sound, connotation and commercial impression. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 1371-72, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005). The Examiner's Brief focuses almost exclusively on the Examiner's proffered meaning of GUNTHER'S (as a "shortened form of registrant's marks") and the undisputed fact GUNTHER are the first seven letters in each mark.

The marks appear and sound different. It is undisputed similarity of appearance must consider the mark as a whole rather than simply comparing common features of the marks. Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 1242, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004)(PUTTING ON THE RITZ "contains words in addition to [RITZ] making both its visual appearance and pronunciation longer"). The one word GUNTHER'S mark is different in appearance to the two word registered marks, GUNTHER TOODY'S and GUNTHER'S GOURMET. Considered as a whole, the marks are different in appearance.

The sound of the two word registered marks also differs from the sound of the one word GUNTHER'S mark. The GUNTHER'S GOURMET mark relies on alliteration that aids in memory. The G-G alliteration of GUNTHER'S GOURMET makes the mark, as a whole, distinct in sound.

A different consideration distinguishes the sound of the GUNTHER TOODY'S mark. GUNTHER TOODY'S does not have a readily apparent pronunciation. The word "toody" can be pronounced by consumers in several ways, including todody (taa-dee), toady (toe-dee), or tuedy, (too-dee). As a whole, the marks are different in sound.

Applicant contends these differences in appearance and sound compared to the one word GUNTHER'S mark contribute to a different commercial impression for the two word registered marks, GUNTHER TOODY'S and GUNTHER'S GOURMET.

The additional word in each registered mark creates a different commercial impression. The Examiner’s Brief focuses on GUNTHER as the initial letters of all three marks¹ and argues consumers focus on the first word in a mark and give less significance to a descriptive word in a mark.² It is undisputed “[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail.” Estate of P.D. Beckwith, Inc., v. Comm’r of Patents, 252 U.S. 538, 545–46, 40 S. Ct. 414, 417, 64 L. Ed. 705 (1920). Even a generic or disclaimed term is considered in comparing the marks as a whole. Juice Generation, Inc. v. GS Enterprises LLC, 794 F.3d 1334, 1341, 115 U.S.P.Q.2d 1671 (Fed. Cir. 2015) (“giving no significance to the term . . . is impermissible notwithstanding that the term is generic and disclaimed”).

The Examiner Brief asserts GOURMET is descriptive, disclaimed, and “has little to no separate source-indicating power.” Here, the use of “GOURMET” in the cited GUNTHER’S GOURMET mark is significant – it adds an elevated level of quality, price or scarcity to the commercial impression of the mark. “Gourmet” is defined as “of, relating to, or being high quality, expensive, or specialty food typically requiring elaborate and expert preparation,” *Gourmet*, Merriam-Webster.com Dictionary. Applicant’s Appeal Brief Exhibit 1. The “GOURMET” element of the registered mark, even if descriptive, is entitled to substantial weight in differentiating registrant’s sauces from applicant’s frozen desserts, especially when considered in combination with the mnemonic G-G alliteration.

The Examiner Brief asserts TOODY’S “has no trademark significance”. The word TOODY’S in the cited GUNTHER TOODY’S mark is significant. It is not a word in English. TOODY’S is fanciful or arbitrary, and therefore inherently distinctive for restaurant services. The “TOODY’S” element of the

¹ More precisely, the Examiner Brief focuses on GUNTHER’S and argues the possessive form has no trademark significance. It is only the letters forming GUNTHER, however, that are identical in all three marks.

² Citing In re Detroit Athletic Co, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018)(applicant sought the mark DETROIT ATHLETIC CO. for use with sports apparel retail services and the registered mark was DETROIT ATHLETIC CLUB for use with clothing). Here there are more than 3 letters difference in the marks and far fewer than 16 letters the same.

registered mark is entitled to significant weight. The GUNTHER TOODY'S mark creates a different commercial impression from GUNTHER'S.

Alternatively, it is undisputed Gunther Toody is a fictional character from the Emmy winning television sitcom "*Car 54 Where are You.*" Feb. 27, 2021 Request for Reconsideration **Exhibit A**, TSDR pp. 20-25, and **Id.**, **Exhibit B**, TSDR p. 27.³ Consumers familiar with the GUNTHER TOODY'S mark know about the eponymous character and are seeking the restaurant's ambiance invoking nostalgia for the early 1960's. "The meaning or connotation of a mark must be determined in relation to the named goods or services." TMEP §1207.01(b)(v).⁴

GUNTHER'S has secondary meaning. The Examiner's Brief argues the meaning of GUNTHER'S is a "shortened form" of the registered marks - GUNTHER TOODY'S and GUNTHER'S GOURMET. Citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed Cir. 2010)(involving application for the mark ML and the registered mark ML MARK LEES used on "nearly identical" skin care products, e.g. "skin soap, body lotion" and "skin cleanser, skin lotion"). Here the goods and services are not nearly identical.

There is no evidence consumers abbreviate either registered mark. Indeed the evidence is that consumers associate GUNTHER'S with the source of ice cream and ice cream parlors, not with the goods sold or services provided under the registered marks. This secondary meaning establishes a string mark and should be considered in the likelihood of confusion analysis.

³ Because this program was televised "nearly sixty years ago", the Examiner questioned "whether an appreciable fraction of consumers today have any awareness of this program or the "Gunther Toody" character in it" Aug. 27, 2020 Final Office Action, TSDR p. 4. The GUNTHER TOODY'S restaurant, based on the TV show, perpetuates consumer awareness of the officer Gunther Toody character.

⁴ The leading treatise provides meaning can be determined from context such as material on labels, packaging, advertising and the like. 4 McCarthy on Trademarks and Unfair Competition § 23:26 (5th ed.).

The application for GUNTHER'S was initially refused as "primarily merely a surname" under Section 2(e)(4). Jan. 21, 2020 Nonfinal Office Action, TSDR p. 4.⁵ In response, Applicant submitted a claim of acquired distinctiveness under Section 2(f). Jan. 21, 2020 Nonfinal Office Action, TSDR p. 5. The Section 2(e)(4) refusal was withdrawn. Aug. 27, 2020 Final Office Action, TSDR p. 1. GUNTHER'S has become distinctive of Applicant's goods and services in the minds of the purchasing public based on the statutory 5 years of continuous and exclusive use. 15 USC §1052(f); 37 CFR 2.41(a)(2); TMEP §§1212.05(e), 1212.06. Indeed GUNTHER'S has 80 years of continuous and exclusive use.

The Examiner's Brief dismisses this secondary meaning as "irrelevant". But the Office has conceded GUNTHER'S is eligible for the principal register and distinguishes Applicant's Goods and Services from those of others - the antithesis of consumer confusion.

There is no evidence consumers identify GUNTHER'S with the registrants' goods and services or the registered marks with Applicant's goods and services. In conjunction with the longstanding concurrent use of the marks without confusion (see Part D below) Applicants secondary meaning for GUNTHER'S is evidence there is no likelihood of confusion. GUNTHER'S is not confusingly similar to GUNTHER TOODY'S or GUNTHER'S GOURMET in meaning or commercial impression.

B. The Goods and Services are Dissimilar.

It is undisputed the goods or services must be related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source. See, e.g., Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1369, 1371, 101 U.S.P.Q.2d 1713, 1722, 1723 (Fed. Cir. 2012).

GUNTHER TOODY'S restaurants. The Examiner argues all restaurant services are "legally identical."⁶ An ice cream parlor does not cater to diners looking for a full meal. A full service restaurant

⁵ The name GUNTHER'S ice cream parlor came from the founders, William and Iva Gunther. Feb. 27, 2021 Request for Reconsideration **Exhibit G**, TSDR p. 49. The Applicant's GUNTHER'S mark has no connection with the officer Gunther Toody character.

⁶ Citing In re i.am.symbolic, llc, 127 USPQ2d 1627, 1629 (TTAB 2018)(dealing with clothing)

may offer desert, but customers expect more. Both GUNTHER'S ice cream parlors and GUNTHER TOODY'S restaurants offer food, but the dining experience is distinct. Quality ice cream is served frozen. Quality hamburgers are not. Both marks have acquired secondary meaning based on customer's different dining experiences coming from different sources.

The Examiner also argues "the description of the goods/services in the application and registration" governs the analysis, not extrinsic evidence of actual use.⁷ Applicant respectfully asserts the specimens are also pertinent.⁸ The specimens submitted for the registered GUNTHER TOODY'S mark demonstrate the restaurant's nostalgic theme, classic cars and vintage styling, paying homage to the character Gunther Toody. Feb. 27, 2021 Request for Reconsideration **Exhibit C**, TSDR pp. 29 – 32. Consumers seek the GUNTHER TOODY'S mark for a specific restaurant experience.

GUNTHER'S GOURMET sauces. The Examiner argues ice cream and sauce are "often used together" and may come from a single source, citing a screenshot from Ghirardelli.com. There is no evidence GHIRARDELLI is used as a mark for ice cream. The GHIRARDELLI trademark is not registered for ice cream or frozen non-dairy confections.⁹

Ice cream and chocolate or strawberry sauce may be consumed together, but there is no reason to conclude typical consumers think they are from the same source. That would be especially true if the hypothetical chocolate sauce is branded GUNTHER'S GOURMET along with other "gourmet" sauces from the same source having no association with ice cream.

The goods in the GUNTHER'S GOURMET registration in class 30 include things other than sauces -- marinades, vinaigrettes, salsa, salad dressings. The Examiner Brief notes the list of items in the

⁷ Citing Stone Lion Capital Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014)(dealing with the trade channels factor)

⁸ The purpose of specimens is to show the manner in which the mark is seen by the public and provide supporting evidence of facts recited in the application. MPEP § 904. See also In re Nationwide Industries, Inc., 6 U.S.P.Q.2d 1882 (T.T.A.B. 1988)(looking to the specimens submitted to identify "the product sold under the mark").

⁹ GHIRARDELLI is registered for restaurant services (US Reg. No. 1,376,695), but the mark is not similar to GUNTHER'S

registration for GUNTHER’S GOURMET used a comma instead of a semicolon before the final item – sauces. Applicant did not intend any misrepresentation and apologizes for this punctuation error. The point remains all of the listed items are “goods in the registration” in class 30 and should inform the likelihood of confusion analysis.¹⁰

Even limiting the analysis of goods in class 30 only to “sauces” includes many goods not used with frozen desserts. Sauce is defined as “a condiment or relish for food especially: a fluid dressing or topping” and “something that adds zest or piquancy. *Sauce*, Merriam-Webster.com Dictionary. Applicant’s Appeal Brief Exhibit 2. “Sauce” includes, for example, hollandaise sauce, alfredo sauce, tartar sauce, cocktail sauce, marsala sauce, marinara sauce, amatriciana sauce, bechamel sauce, and gorgonzola sauce. Feb. 27, 2021 Request for Reconsideration **Exhibit I**, TSDR pp. 55 – 62. The specimen¹¹ submitted to show use of GUNTHER’S GOURMET with sauces depicted “pineapple orange hot sauce with mango.” Feb. 27, 2021 Request for Reconsideration **Exhibit J**, TSDR pp. 64 – 69. None of the specimens include chocolate sauce or toppings suitable for ice cream.¹²

GUNTHER’S ice cream can be and often is consumed without any added sauce. GUNTHER’S GOURMET sauces are not consumed alone; instead they enhance the enjoyment of another food, not necessarily originating from the same source.

Consumers do not understand GUNTHER’S GOURMET “sauces” to refer to ice cream toppings.

C. The Trade Channels are Dissimilar.

Goods and services are *presumed* to travel in the same channels of trade to the same class of purchasers. In re Viterra Inc., 671 F.3d 1358, 1362, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012). The Examiner

¹⁰ A semicolon was used because the application was based on intent to use for “sauces, pico de gallo sauce, picante sauces”. Application No. 85453128, TSDR p. 1. Actual use was claimed for the other class 30 goods. The statement of use filed in 2014 deleted “pico de gallo sauce, picante sauces”.

¹¹ See note 8 above on the use of specimens to define the goods

¹² The specimen filed with the application for GUNTHER’S GOURMET was for “orange balsamic vinaigrette & marinade.” The remaining specimens submitted in 2020 were for salsas: “crab salsa,” “lime mango salsa,” and “tropical style mango salsa with lime,”

Brief *asserts* that the services offered under GUNTHER’S and GUNTHER TOODY’S, and goods offered under GUNTHER’S and GUNTHER’S GOURMET, are identical and therefore reach the same consumers in the same channels of trade. However, an applicant can produce evidence to rebut this presumption. Zheng Cai v. Diamond Hong, Inc., 901 F.3d 1367, 1372, 127 U.S.P.Q.2d 1797 (Fed. Cir. 2018).

GUNTHER TOODY’S restaurants. The Examiner contends ice cream parlors are subsumed in restaurant services and therefore identical for purposes of registration. Certainly not all restaurants are the same and consumers exercise care in choosing a restaurant or ice cream parlor based on many factors - menu, price, location, prior experience or reputation, etc. A GUNTHER’S ice cream parlor has a totally different ambiance, menu and price structure than a Gunther Toody character themed restaurant.

Likelihood of confusion is further dispelled because consumer exercise care in selecting restaurants. See Barbecue Marx, Inc. v. 551 Ogden, Inc., 235 F.3d 1041, 1045, 57 U.S.P.Q.2d 1307 (7th Cir. 2000) (“We can expect that customers will exercise a reasonable degree of care when planning to dine at a restaurant of [defendant's \$20/meal] caliber.”).

GUNTHER’S GOURMET sauces. Ice cream and sauces not are identical, the examiner merely contends they are related. GUNTHER’S ice cream and non-dairy frozen confections, if available in the store, would be found in the freezer section. They “must be consumed promptly after receipt, or otherwise must be transported and stored at low temperatures.” Klopp Declaration, ¶ 9. Frozen desserts are not shelf stable because they melt.

In contrast, GUNTHER’S GOURMET sauces (even, *arguendo*, Ghirardelli chocolate “sauces”) are shelf stable, easily shippable, and can be consumed months or years after purchase. GUNTHER’S GOURMET sauces are sold online. Feb. 27, 2021 Request for Reconsideration **Exhibit J**, TSDR pp. 65 – 67; **Id.**, **Exhibit K**, TSDR pp. 71 - 74. The channels of trade are inherently different.

Again the care exercised by customers is also different. Consumers seeking “gourmet” food are understood to be more discerning regarding the desired goods and less likely to be confused as to source.

D. Concurrent Use Without Actual Confusion.

Concurrent use for a considerable time without any evidence of confusion is “a factor which may properly be given some weight.” Smith v. Tobacco By-Products and Chemical Corp., 243 F.2d 188, 190, 113 U.S.P.Q. 339 (C.C.P.A. 1957). The Examiner’s Brief gives no weight to this evidence against likelihood of confusion and asserts “uncorroborated statements of no known instances of actual confusion . . . are of little evidentiary value.” In re Majestic Distilling Co. 315 F.3d 1311, 1317, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). Here there are undisputed corroborating facts.

Applicant’s Mark GUNTHER’S has been in use since 1940 – over 80 years.¹³ Despite nearly 33 years of concurrent use of the registered GUNTHER TOODY’S mark, and 20 years of concurrent use of the registered GUNTHER’S GOURMET mark, Applicant is aware of no evidence of any confusion.

Applicant sells nearly 200,000 gallons of ice cream alone each year and Applicant, and its goods and services have garnered unsolicited media attention.¹⁴ The storefront is, in fact, Sacramento’s oldest ice cream parlor.¹⁵ Under these circumstances GUNTHER’S has achieved secondary meaning and a degree of fame. Concurrent use without confusion indicates confusion is unlikely.

E. Division by Class

The Application to register GUNTHER’S should proceed to be published for opposition in both class 43 and class 30. Each Registration was cited ‘solely’ to create likelihood of confusion in one class. This treatment is proper because sale of private label ice cream in a restaurant does not create confusion any time another ice cream is branded with a mark similar to the restaurant. In re Coors Brewing Co., 343 F.3d 1340, 1346, 68 U.S.P.Q.2d 1059, 1064 (Fed. Cir. 2003). So use of GUNTHER’S GOURMET on sauces does not bar use of GUNTHER’S for a restaurant, and use of GUNTHER TOODY’S for a restaurant does not bar use for GUNTHER’S frozen desserts.

¹³ Klopp Declaration, ¶ 3.

¹⁴ E.g., Feb. 27, 2021 Request for Reconsideration **Exhibit L**, TSDR pp. 76 – 79; **Id.**, **Exhibit M**, TSDR p. 83; and **Id.**, **Exhibit O**, TSDR pp. 95 – 97.

¹⁵ Feb. 27, 2021 Request for Reconsideration **Exhibit G**, TSDR p. 49.

Because each class in a multi-class application is considered to be a separate application, the Board may affirm a refusal as to one class and reverse a refusal as to a different class. TBMP §1217 n.6. Registration can issue separately for either class in the Application if likelihood of confusion is not shown for that class.

SUMMARY

For decades Applicant has been continuously and exclusively using the GUNTHER'S mark for ice cream, non-dairy frozen confections, and frozen dessert parlors. The GUNTHER'S mark has secondary meaning supported by media attention and commercial success. This acquired distinctiveness corroborates the absence of actual confusion with either the GUNTHER TOODY'S diners or GUNTHER'S GOURMET sauces. The GUNTHER'S Mark and the associated goods and services are not confusingly similar to the marks and goods/services in the registrations cited by the Office. Confusion is not likely.

Applicant respectfully requests the final refusal to register be withdrawn as to both Class 30 and Class 43, and the application be allowed proceed to publication.

Dated: August 26, 2021

Respectfully Submitted,

By: /s/ Marcus N. DiBuduo
Marcus N. DiBuduo, Esq.
Ray Harris, Esq.
FENNEMORE CRAIG, P. C.
8080 N. Palm Ave., 3rd Floor
Fresno, CA 93711
Phone: 559-432-4500
Facsimile: 559-432-4590
Email: ipmail@dowlingaaron.com
Attorneys for Applicant